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DEC 10 2007

OFFICE OF PETITIONS

In re Application of	:	
Ryoji Kaneko	:	
Application No. 10/709,971	:	DECISION ON PETITIONS
Filed: June 10, 2004	:	PURSUANT TO 37 C.F.R.
Attorney Docket Number:	:	\$\$ 1.137(A), AND 1.137(B)
SIMTEK6915	:	
Title: BRUSH TYPE DC ELECTRIC	:	
MACHINE	:	

On September 9, 2006, Petitioner presented a submission, which is properly treated as a petition pursuant to 37 C.F.R. § 1.181 to review a decision of a Technology Center Director, as well as petitions pursuant to 37 C.F.R. § 1.137(a)¹ and 37 C.F.R. § 1.137(b)² to revive the above-identified application.

1 A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

2 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (2) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;

Duplicate copies of this submission were submitted on September 10, 2006 and November 3, 2006.

This is a decision on the petitions pursuant to 37 C.F.R. §§ 1.137(a) and (b). A decision on the petition pursuant to 37 C.F.R. § 1.181 will be mailed under separate cover.

The Office regrets the period of delay in issuing this decision.

The petition pursuant to 37 C.F.R. § 1.137(a) is **DISMISSED**.

The petition pursuant to 37 C.F.R. § 1.137(b) is **DISMISSED**.

A discussion follows.

Background

The above-identified application became abandoned for failure to submit an Appeal Brief within two-months of the filing of a Notice of Appeal, filed on December 20, 2005. An Appeal Brief was received on August 7, 2006 along with the required fee. No extensions of time pursuant to 37 C.F.R. §1.136(a) were received. Accordingly, the above-identified application became abandoned on February 21, 2006. A Notice of Abandonment was mailed on September 5, 2006.

The Relevant Portions of the C.F.R. and M.P.E.P.

37 C.F.R. § 1.181(f) sets forth, *in toto*:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

(3) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

37 C.F.R. § 1.136(a)(1) sets forth, *in toto*:

(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

- (i) Applicant is notified otherwise in an Office action;
- (ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;
- (iii) The reply is a request for an oral hearing submitted pursuant to § 41.47(a) of this title;
- (iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.304 or to § 41.50 or § 41.52 of this title; or
- (v) The application is involved in a contested case (§ 41.101(a) of this title).

(2) The date on which the petition and the fee have been filed is the date for purposes

37 C.F.R. § 41.37(a)(1) sets forth, *in toto*:

Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

M.P.E.P. § 1205.01 sets forth, *in pertinent part*:

37 CFR 41.37(a) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief and the appeal brief fee set forth in 37 CFR 41.20(b)(2). In an ex parte reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274.

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2-month time period is measured. See MPEP § 512. If the notice of appeal is filed in accordance with 37 CFR 1.10 using

the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS), the date of deposit with the USPS is the date from which this 2-month time period is measured because the date of deposit shown by the "date in" on the "Express Mail" label or other official USPS notation is considered to be the date of receipt. See MPEP § 513.

ANALYSIS OF THE PETITIONS PURSUANT TO
37 C.F.R. §§ 1.137(A) AND 1.137(B)

Petition fee requirement

The fee for filing a petition to revive an unavoidably abandoned application under 37 C.F.R. § 1.137(a) is set forth in 37 C.F.R. § 1.17(l) as being \$510 for a large entity and \$255 for a small entity.

The fee for filing a petition to revive an unintentionally abandoned application under 37 C.F.R. § 1.137(b) is set forth in 37 C.F.R. § 1.17(m) as being \$1,540 for a large entity and \$770 for a small entity.

There is no record of any fee having been received along with either of these petitions, and the electronic file does not appear to contain an authorization to charge any deficiencies to a Deposit Account. Therefore, the second requirement of both 37 C.F.R. §§ 1.137(a) and 1.137(b) has not been met.

It is noted that Petitioner has requested the waiver of the fee that is associated with the filing of the petition pursuant to 37 C.F.R. § 1.137(a). This request cannot be granted however, as the payment of the required petition fee is a prerequisite to the filing of a petition to revive under 37 C.F.R. § 1.137. Therefore, consideration of the merits of the petition before receipt of the filing fee would be premature. See M.P.E.P. 711.03(c)(III)(B)³

³ "...[T]he payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application and cannot be waived. In addition, the phrase '[o]n filing' in 35 U.S.C. §41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 C.F.R. §1.137. See H.R. Rep. No. 542, 97th Cong., 2nd Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ('[t]he fees set forth in this section are due on filing the petition'). Therefore, the Office...will not reach the merits of any petition under 37 C.F.R. § 1.137 lacking the requisite petition fee."

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§ 1.137(a) and/or 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Any submission in response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁷.

If responding by mail, Petitioner is advised not to place the name of the deciding official on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the decision maker.

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanowski at (571) 272-3225⁸. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanowski/
Paul Shanowski
Senior Attorney
Office of Petitions

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

6 (571) 273-8300- please note this is a central facsimile number.

7 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

8 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.